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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/474,317	12/29/1999	GREGG HOMER	22292-000100US	2106
51111	7590	08/07/2007		
AKA CHAN LLP 900 LAFAYETTE STREET SUITE 710 SANTA CLARA, CA 95050			EXAMINER MIRZA, ADNAN M	
			ART UNIT 2145	PAPER NUMBER
			NOTIFICATION DATE 08/07/2007	DELIVERY MODE ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PTO-INBOX@AKACHANLAW.COM

## Office Action Summary

**Application No.**

09/474,317

**Applicant(s)**

HOMER, GREGG

**Examiner**

Adnan M. Mirza

**Art Unit**

2145

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 29 May 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Claim Rejections - 35 USC § 103*

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 1-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Treka et al (U.S. 6,453,345) and further in view of Kuzma (U.S. 5,771,355).

As per claims 1,7,10,20,22 Treka disclosed a method for tracking the transmission of a digital file over the Internet comprising the steps of: receiving packets constituting segments of the file in transit over the Internet (col. 2, lines 22-34); and sending the received packets unaltered to a next Internet leg in the transmission path of the file (col. 9, lines 60-67 & col. 10, lines 1-9).

However Treka did not disclose in detail, "examining file headers in said packets to determine the presence of specific identifying indicia therein".

In the same field of endeavor Kuzma disclosed, as will be understood, attachment reference is either a logical pointer or logical path that indicates either where the attachment, or copy of it

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resides. As will further be appreciated by those skilled in the art. A URL is a logical path used in the www HTTP. (col. 6, lines 25-28).

It would have been obvious to one having ordinary skill in the art at the time of the invention was made to have incorporated as will be understood, attachment reference is either a logical pointer or logical path that indicates either where the attachment, or copy of it resides. As will further be appreciated by those skilled in the art. A URL is a logical path used in the www HTTP as taught by Kuzma in the method of Treka reduce the costly needed resources in the network and reduce congestion.

3. As per claim 2 Treka-Kuzma disclosed including the additional step of recording the Internet Protocol header destination address for the file (Treka, col. 3, lines 40-48).

4. As per claims 3,4 Treka-Kuzma disclosed including the additional step of transmitting said identifying indicia and said source Internet address to a proprietor of the file (Kuzma, col. 6, lines 25-28).

5. As per claims 5,8,21 Treka-Kuzma disclosed wherein said examining step further includes: searching said file headers for TCP headers containing port numbers indicative of an email message; searching each of said packets (Treka, col. 14, lines 62-67), in which port numbers indicative of email messages were found, for an attachment; and when said attachment

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is found, locating the source Internet address in an IP header for the file containing the attachment (Treka, col. 15, lines 1-4).

6. As per claims 6,9,13,26 Treka-Kuzma disclosed wherein said identifying indicia comprises a user defined character sequence selected from the group consisting of: an extension to an existing file format, prepended to the file; a sequence of bits embedded in the file; and an absence of code in a predefined area within the file (Kuzma, col. 5, lines 29-48).

7. As per claim 11 this claim differ from the claim 1 in that recording step, e.g. claim 1 recites "recording the Internet Protocol header source address" and claim 11 recites the same thing with different wording therefore, it is rejected accordingly.

8. As per claim 12 Treka-Kuzma disclosed wherein said examining step further includes: searching said file headers for TCP headers containing port numbers indicative of email messages (Kuzma, col. 12, lines 34-49); searching each of said packets, in which port numbers indicative of email messages were found, for a MIME header indicative of an attachment (Kuzma, col. 12, lines 50-64); and when said MIME header indicative of an attachment is found: searching a header directly prepended to the file to find said identifying indicia therein, when said MIME header is indicative of an attachment containing a type of said file sought; and locating the source Internet address in an IP header for the file containing the attachment, when said identifying indicia is found (Kuzma, col. 6, lines 25-28).

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9. As per claim 14 Treka-Kuzma disclosed substantially the invention including a method for tracking the transmission of a digital file over the Internet comprising the steps of: placing identifying indicia in said digital file; using a data communications monitoring device to capture packets of information being transmitted via the Internet without the alteration of the captured packets (Treka, col. 14, lines 37-49); examining certain ones of said packets to determine the presence of said identifying indicia in said file (Kuzma, col. 6, lines 25-28); and recording the source and destination Internet addresses for each of the packets containing said identifying indicia, and the identity of the file associated therewith (Kuzma, col. 6, lines 25-28).

10. As per claim 15 Treka-Kuzma disclosed wherein said identifying indicia is prepended to said header (Kuzma, col. 6, lines 25-28).

11. As per claim 16 Treka-Kuzma disclosed wherein said identifying indicia is embedded in said file (Kuzma, col. 6, lines 25-28).

12. As per claim 17 Treka-Kuzma disclosed the invention substantially including a method for tracking the transmission of a digital file over the Internet comprising the steps of: receiving packets constituting segments of the file in transit over the Internet; searching said packets for TCP headers containing port numbers indicative of email messages (Kuzma, col. 12, lines 34-49); searching each of said packets, in which said port numbers indicative of email messages were found, for a MIME header indicative of an attachment; and when said MIME header indicative of an attachment is found (Kuzma, col. 6, lines 25-28): searching a header directly

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prepended to the file to locate said identifying indicia therein, when said MIME header is indicative of an attachment containing a type of said file sought; locating the source Internet address in an IP header for the file containing the attachment containing the type of said file sought, when said identifying indicia is located; and recording, for each of the packets containing said identifying indicia, the source Internet address for the file (Kuzma, col. 12, lines 50-64); and sending the received packets unaltered to a next internet leg in the transmission path of the file (Treka, col. 14, lines 37-49).

13. As per claims 18,19 Treka-Kuzma disclosed including the additional step of transferring said identifying indicia and said source Internet address to a proprietor of the file (Treka, col. 14, lines 37-49).

14. As per claim 23 Treka-Kuzma disclosed wherein said identifying indicia is located in a header having a field indicating that the frame size thereof is zero bytes in length (Kuzma, col. 6, lines 25-28).

15. As per claims 24,25 Treka-Kuzma disclosed wherein said identifying indicia is located in a header having a frame size field indicating that there is no information field appended to the frame size field (Kuzma, col. 6, lines 25-28).

***Response to Arguments***

16. Applicant's arguments filed 05/29/2007 have been fully considered but they are not persuasive. Response to applicant's argument is as follows.

A. Applicant argued that there is no suggestion or motivation, either in the references themselves or in the knowledge generally available to one of the ordinary skill in the art, to combine the cited references. The combination is improper because neither reference suggests a modification of nor an improvement to what is described in the other reference.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, taught by Kuzma in the method of Treka reduce the costly needed resources in the network and reduce congestion.

B. Applicant argued that prior art did not disclose, "examining file headers in the packets to determine the presence of specific identifying indicia".



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As to applicant's argument Kuzma disclosed, "as will be understood, attachment reference is either a logical pointer or logical path that indicates either where the attachment, or copy of it resides. As will further be appreciated by those skilled in the art. A URL is a logical path used in the www HTTP. (col. 6, lines 25-28)". Applicant's attorney interpreting the claims too narrow.

### ***Conclusion***

**17. THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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18. Any inquiry concerning this communication or earlier communication from the examiner should be directed to Adnan Mirza whose telephone number is (571)-272-3885.

19. The examiner can normally be reached on Monday to Friday during normal business hours. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jason Cardone can be reached on (571)-272-3933. The fax for this group is (703)-746-7239. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

20. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at (866)-217-9197 (toll-free).



Adnan Mirza

Examiner



JASON CARDONE  
SUPERVISORY PATENT EXAMINER